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| 22852 | 7590 | 08/29/2006 | EXAMINER | |
| FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413 | | | LUONG, VINH | |
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| | | | 3682 | |

DATE MAILED: 08/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/777,105

Applicant(s)

FUJIWARA, NOBORU

Examiner

Vinh T. Luong

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3682

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 5,7 and 9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,6,8 and 10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.


Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☒ All b) ☐ Some * c) ☐ None of:

1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.


Vinh T. Luong
Primary Examiner

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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1. The Amendment filed on August 7, 2006 has been entered.
2. Claims 5, 7, and 9 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. The election was made **without** traverse in the reply filed on April 28, 2006.
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claims 1, 2, and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by Tulaczko et al. (US Patent No. 6,679,366 B2 filed on January 18, 2002).

Regarding claim 1, Tulaczko teaches a pedal reaction force device for applying a prescribed reaction force to an operating pedal 1b, 1c (Figs. 2 and 3) to be depressed by pedaling, comprising: a reaction force generating unit 2-9 for applying a pedaling reaction force to said operating pedal 1b, 1c on the basis of displacement due to said operating pedal 1b, 1c being mechanically displaced in accordance with a pedaling operation; and a displacement characteristics regulating mechanism 18a, 19a (Fig. 2), 18b, 19b (Fig. 3) disposed between said reaction force generating unit 2-9 and said operating pedal 1b, 1c which transmits said reaction force to said operating pedal 1b, 1c and simultaneously mechanically sets a variation pattern of displacement magnitude of said reaction force generating unit 2-9 with respect to a pedaling stroke of said operating pedal 1b, 1c;

wherein said reaction force generating unit comprises a damper device 2, 4-9 for applying the pedaling reaction force to said operating pedal 1b, 1c on the basis of circulation resistance of a fluid (*id.*, col. 3, lines 39-41) by being mechanically compressed or tensioned in accordance with said pedaling operation of said operating pedal 1b, 1c (*id.* col. 3, lines 32-41);

a spring member 3a, 3b for applying a pedaling reaction force to said operating pedal 1b, 1c on the basis of resilient deformation by being mechanically and resiliently deformed in accordance with said pedaling operation of said operating pedal 1b, 1c; and

wherein the pedaling reaction force of the damper device 2, 4-9 differs according to the pedal speed.

Regarding claim 2, said displacement characteristics regulating mechanism 18a, 19a (Fig. 2), 19b, 18b (Fig. 2) *intervenes* between said damper device 2, 4-9 and/or said spring member 3a, 3b and said operating pedal 1b, 1c.

Regarding claim 10, Tulaczko's pedal reaction force device is capable of being applied to an electric pedal device. Note that when each element of a patent claim is found in one prior art reference, the claim is invalid, and the invention is said to be anticipated as a matter of law. This is true, even if the intended use of the anticipating device is different from the intended use of the claimed device. *Mathis v. Hydro Air Industries*, 1 U.S.P.Q.2d 1513, 1523 (DC C. Calif. 1986) and cases cited therein. Further, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

5. Claims 1-4, 6, 8, and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Fabrice (EP 0 919 903 A1 cited by Applicant).

Regarding claim 1, Fabrice teaches a pedal reaction force device for applying a prescribed reaction force to an operating pedal 1a, 21a to be depressed by pedaling, comprising:

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a reaction force generating unit 20, 16 for applying a pedaling reaction force to said operating pedal 1a, 21a on the basis of displacement due to said operating pedal 1a, 21a being mechanically displaced in accordance with a pedaling operation; and a displacement characteristics regulating mechanism 10 disposed between said reaction force generating unit 20, 16 and said operating pedal 1a, 21a which transmits said reaction force to said operating pedal 1a, 21a and simultaneously mechanically sets a variation pattern of displacement magnitude of said reaction force generating unit 20, 16 with respect to a pedaling stroke of said operating pedal 1a, 21a;

wherein said reaction force generating unit 20, 16 comprises a damper device 20, 16 for applying said pedaling reaction force to said operating pedal 1a, 21a on the basis of circulation resistance of a fluid (air or hydraulic. *Ibid.* paragraph [0036] of the translation) by being mechanically compressed or tensioned in accordance with said pedaling operation of said operating pedal 1a, 21a;

a spring member 12 for applying said pedaling reaction force to said operating pedal 1a, 21a on the basis of resilient deformation by being mechanically and resiliently deformed in accordance with a pedaling operation of said operating pedal 1a, 21a; and

wherein the pedaling reaction force of the damper device differs according to the pedal speed.

Regarding claim 2, wherein said displacement characteristics regulating mechanism 10 intervenes between said damper device 20, 16 and/or said spring member 12 and said operating pedal 1a, 21a.

Regarding claim 3, said spring member 12 is a coil spring 12 that is substantially *concentrically* disposed at the outer circumferential side of said damper device 20, 16 so as to surround said damper device 20, 16 and is compressed and tensioned in an integrated manner with said damper device 20, 16 in accordance with said pedaling operation of said operating pedal 1a, 21a, and a variation pattern of displacement magnitude of said spring member 12 and said damper device 20, 16 is defined by a single displacement characteristics regulating mechanism.

Regarding claims 4, 6, and 8, said operating pedal 1a, 21a is turned around a substantially horizontal support shaft 2, 22 by a pedaling operation, said displacement characteristics regulating mechanism is a cam 10 whose dimension from said support shaft 2, 22 is continuously varied and which is turned around said support shaft 2, 22 in an integrated manner with said operating pedal 1a, 21a, and said reaction force generating unit 20, 16 is engaged with said cam 10 and is displaced in accordance with a variation pattern corresponding to a profile of a cam surface 10.

Regarding claim 10, Fabrice's pedal reaction force device is capable of being applied to an electric pedal device. Note that when each element of a patent claim is found in one prior art reference, the claim is invalid, and the invention is said to be anticipated as a matter of law. This is true, even if the intended use of the anticipating device is different from the intended use of the claimed device. *Mathis v. Hydro Air Industries, supra*. Further, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the

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prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey* and *In re Otto, supra*.

6. Applicant's arguments filed August 7, 2006 have been fully considered but they are not persuasive.

35 USC 112

The previous rejection under 35 USC 112, second paragraph, is withdrawn in view of Applicant's amendment.

ART REJECTION

Takayama

The rejection based on Takayama is withdrawn in view of Applicant's amended claim 1. Applicant's arguments regarding Takayama are deemed to be moot.

Tulaczko

Applicant contended that Tulaczko fails to disclose that the damper differs the pedaling reaction force according to pedaling speed.

On the one hand, it is well settled that a "whereby" or "wherein" clause that merely states the inherent result of the limitations set forth in the claim adds nothing to the patentability or substance of the claim. *Texas Instrument Inc. v. International Trade Commission*, 26 USPQ2d 1018 (Fed. Cir. 1993); *Griffin v. Bertina*, 62 USPQ2d 1431 (Fed. Cir. 2002) and *Amazon.com Inc. v. Barnesandnoble.com Inc.*, 57 USPQ2d 1747 (Fed. Cir. 2001).

On the other hand, the Examiner respectfully submits that Applicant's contention is unsupported by substantial evidence in the record. In fact, Tulaczko's Figs. 2 and 3 show that the pedaling reaction force of the damper 2, 4-9 inherently differs according to the pedal speed.

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The reason is that the pedal 1b, 1c is directly connected to the tappet 5 by the head 7, thus, when the speed of the pedal 1b, 1c varies, the speeds of the tappet 5, piston 4, and hydraulic fluid are varied therewith, consequently, the reaction/resistance force of the fluid of the damper in the cylinder 2 is varied therewith as seen by the graphs in Fig. 4. *Ibid.* col. 3, lines 32-41 and col. 4, lines 42-59.

Our reviewing Court in *Perricone v. Medicis Pharmaceutical Corp.*, 77 USPQ2d 1321 (CAFC 2005) stated “A single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation. *Minn. Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 1565 [24 USPQ2d 1321] (Fed. Cir. 1992). Thus, a prior art reference without express reference to a claim limitation may nonetheless anticipate by inherency. See *In re Cruciferous Sprout Litig.*, 301 F.3d 1343, 1349 [64 USPQ2d 1202] (Fed. Cir. 2002). “Under the principles of inherency, if the prior art necessarily functions in accordance with, or includes, the claims limitations, it anticipates.” *Id.* (quoting *MEHL/Biophile Int’l Corp. v. Milgraum*, 192 F.3d 1362, 1365 [52 USPQ2d 1303] (Fed. Cir. 1999)).

In the instant case, Tulaczko necessarily functions in accordance with, or includes, the claims limitations as explained above, thus, it anticipates Applicant’s claims.

Fabrice

Applicant contended:

Contrary to the Examiner’s position regarding the disclosure of Fabrice, Applicant asserts that element 20 in Fabrice is a cylindrical seat, and that element 16 is a guide stud. *Neither component applies a pedaling reaction force to an operating pedal on the basis of circulation resistance of a fluid, or differentiates*

pedaling reaction force according to pedaling speed. (Emphasis added).

At the outset, the Examiner is mindful that Fabrice is cited as a particularly relevant reference if taken alone (X category) in the European Search Report of Applicant's corresponding EP Application.

Moreover, the Examiner respectfully submits that Applicant's arguments are not based on the limitations appearing in the claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In the case at hand, Applicant's claim 1 does not specify the type of "fluid." Therefore, the air compressed by Fabrice "reads on" the claimed element "fluid." In fact, Applicant also uses the air as the fluid medium in Applicant's claimed device as seen in paragraph [0035] of US Patent Application Publication No. 2005/0172753 of Applicant's Application.

In the instant case, when Fabrice's spring 12 is compressed or expanded, the guide block 16 is moved therewith to compress or expand the air between the block 16 and the cylindrical part 20 (*id.* paragraph [0021] of the translation). The compression or expansion (*i.e.*, the deformation) of the air and spring is in accordance with the pedaling operation of the pedal 1a, 21a since when the pedal 1a, 21a moves, the cam 10, the rolling means 11, and the spring 12 are moved therewith as shown in Figs. 1-3.

On the other hand, Fabrice's Figs. 1-3 reveal that the cam 10 is abutted with the rolling means 11, meanwhile, the rolling means 11 is directly connected with the spring 12, therefore, if the pedal 1a, 21a is moved faster or slower, the spring 12 is compressed/expanded faster or slower therewith. *Ibid.* paragraph [0032] and claims 1-6 in the translation. In other words, the

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pedaling reaction force of Fabrice's damper differs according to the pedaling speed *in the same manner as Applicant's device*. Simply put, Fabrice necessarily functions in accordance with, or includes, the claims limitations as explained above, thus, it anticipates Applicant's claims. *In re Cruciferous Sprout Litig., supra*.

For the foregoing reasons, Applicant's request to favorably reconsider the claims is respectfully declined.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vinh T. Luong whose telephone number is 571-272-7109. The examiner can normally be reached on Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Ridley can be reached on 571-272-6917. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Luong

August 25, 2006

A handwritten signature in black ink, appearing to read 'Vinh T. Luong', with a long horizontal flourish extending to the right.

Vinh T. Luong
Primary Examiner